

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: MICHAEL STOCHOSKY	Group Art Unit: 2146
Serial No.: 10/781,029	Examiner: Gerald A. Smarth
Confirmation No.: 2832	Atty. Dkt.: 2095.004196
Filed: February 17, 2004	Client Ref.: P3073XUS1
For: PEER-TO-PEER IDENTITY-BASED ACTIVITY SHARING	CUSTOMER NO.: 62293

REMARKS CONCERNING PRE-APPEAL BRIEF -- REQUEST FOR REVIEW

MAIL STOP APPEAL BRIEF- PATENT

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant submits the following remarks concerning the Pre-Appeal Brief Request for Review filed concurrently herewith. The following remarks show that there are clear errors in the Examiner's rejections. If an extension of time is required to enable this paper to be timely filed and there is no separate Petition for Extension of Time filed herewith, this paper is to be construed as also constituting the proper Petition for Extension of Time Under 37 CFR § 1.136.

No fees are believed to be due as a result of this document (a Notice of Appeal is being concurrently filed with appropriate fees). However, in the event any other fees under 37 C.F.R. §§ 1.16 to 1.21 are required, Commissioner is authorized to deduct the fees from Williams Morgan & Amerson, P.C. PTO Deposit Account No. 50-0786/2095.004196.

The Examiner rejected claims 1-38 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 7,080,139 (*Briggs*) in view of U.S. Pub. 2002/0076025 (*Liversidge*). The Examiner imposed these rejections in the Final Office Action mailed April 29, 2008. The Examiner issued an Advisory Action on August 5, 2008 maintaining the rejections in the Final Office Action.

The Examiner's statements in the Final Office Action represent clear errors. The cited art does not anticipate, make obvious or suggest all of the elements of the pending claims. In particular, contrary to Examiner's position, *Briggs* in view of *Liversidge* does not teach or suggest all the elements of any claim in the instant Application.

For ease of illustration, claim 1 is discussed first. Claim 1, directed to an apparatus for sharing identity-based activity with at least one peer, calls for (1) a content daemon to detect and store identity-based activity, and (2) an instant messaging module, communicatively coupled to the content daemon, to send an indication of identity-based activity to at least one peer, the identity-based activity related to a user logged-in to the instant messaging module.

By way of a non-limiting example, an apparatus that can store identity based activity and then share that information using an instant messaging module may, for example, allow users to share such information in real-time. Identity-based activity, as defined in the Specification, includes activities of a particular user such as web-based auctions and transactions. *See* Specification, p.2, ll. 9-19. Real-time sharing of such content allows a user's peers to view the user's current online downloads as they happen.

Contrary to Examiner's position, *Briggs* in view of *Liversidge* does not anticipate all the elements of any claim in the instant Application. For example, with respect to the claimed feature of an instant messaging module, communicatively coupled to the content daemon, to send an indication of identity-based activity to at least one peer, the identity-based activity related to a user logged-in to the instant messaging module, the Examiner has admitted that *Briggs* does not teach a instant message module (*see* Final Office Action, p. 5). The Examiner suggests, however, that this claimed feature is taught by *Liversidge*. *See id.* Specifically, the Examiner relies on ¶[0073] of *Liversidge* which states "an instant messaging server 84 which

interacts with the collaboration manager 76 to provide specialized services with respect to the management and control of instant messaging sessions.” Even if this is true, the *Liversidge* reference is silent regarding identity-based activities (e.g., downloads the user is currently receiving), much less sending indications of such activities to at least one peer.

The Examiner has attempted to combine a reference that teaches the use of an instant messaging-type application in a “Virtual Team Environment” (VTE) in order to account for the claimed feature of an instant messaging module, communicatively coupled to the content daemon, to send an indication of identity-based activity to at least one peer, the identity-based activity related to a user logged-in to the instant messaging module. As *Liversidge* is silent regarding this feature *in its entirety*, the combination of this reference with the teachings of *Briggs* is not proper. Essentially, the Examiner has used pure and improper hindsight reasoning to incorporate only the teaching of an instant messaging module into a claim feature that also requires the instant messaging module to be communicatively coupled to the content daemon, to send an indication of identity-based activity to at least one peer, the identity-based activity related to a user logged-in to the instant messaging module. In other words, adding the disclosure of *Liversidge* does not make up for the deficit of *Briggs*. The Examiner has not pointed to any suggestion or motivation to combine these references aside from the words “instant messaging module” found in *Liversidge*.

Similarly, the mention of “provid[ing] specialized services” in *Liversidge*, ¶[0073], fails to teach the claimed feature of an instant messaging module, communicatively coupled to the content daemon, to send an indication of identity-based activity to at least one peer, the identity-based activity related to a user logged-in to the instant messaging module. *Liversidge* discloses that functionality within the VTE may be altered or removed depending on the capabilities of the

participants' communications devices (e.g., if a communications unit cannot support a graphical user interface, a text display manager may be used, or if a POTS telephone handset is used, the GUI manager, transport manager, collaboration client, and database clients may be omitted). There is no basis for reading the claimed feature of instant messaging module sending an indication of identity-based activity to at least one peer, the identity based activity related to a user logged-in to the instant messaging module into the subject matter of *Liversidge*, associated with "provid[ing] specialized services."

In the Advisory Action, the Examiner argues that *Briggs* teaches identity based activities. In particular, the Examiner argues that the vague "collective experience" term used in *Briggs* teaches this claimed feature. See Final Office Action, p.4-5. The Examiner's argument, however, is purely speculative in nature because *Briggs* is silent with respect to identity based activities. Simply because a computer may allow a user the possibility to do something, does not mean the user will do it; likewise, this reference does not actually teach the claimed feature of identity-based activities, as called for in claim 1. The Examiner also argues in the Advisory Action that *Liversidge* teaches identity based activity in ¶[0085] by disclosing "team documents" and "public communications" that are available for all users to see in the Virtual Team Environment. See *Liversidge*, ¶[0085]. *Liversidge* teaches a collaboration tool that allows users to share a work space, communications and common documents. *Liversidge* does not teach gathering information on identity based activities (i.e., activities about a user's private online endeavors [see Specification, p.2, ll. 9-19] and providing the information to a peer who would otherwise not have access to such information. In contrast, claim 1 calls for such a feature.

As such, the Examiner's rejection fails because *Briggs* and *Liversidge*, alone or in combination, fail to teach at least one of the claimed features. Accordingly, Applicant

respectfully submits that claims 1-38 are allowable over the cited art and request the rejection under 35 U.S.C. §103 be withdrawn.

With respect to the Examiner's objection of "computer-readable medium," Applicant respectfully asserts that a showing of antecedent basis has been made clear in the Response to Final Office Action, p. 9-10. *See also* Specification, p.15, ll. 9-15. The Examiner argues that software could be a medium in which code/instructions/data are written. *See* Advisory Action. The Examiner's position is untenable. Software is code/instructions/data. One does not write code on software; the two are synonymous. Software (*i.e.*, code) is written upon computer-readable media such as diskettes, CD-ROMs, RAMs, hard drives, and like, which enable a computing device to read the software and execute the instructions within.

With respect to the Examiner's rejection of claims 1-15 and 38 under 35 U.S.C. §101, Applicant respectfully directs the Examiner's attention to p.10-11 of the Response to Final Office Action. Applicant is claiming an apparatus that uses a daemon to perform a function (a Beauregard claim is an article that uses computer code to allow a processor to perform a method, for example). As such, Applicant requests that the Examiner's rejection under §101 and objection of "computer-readable medium" be withdrawn.

Respectfully submitted,

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Date: September 5, 2008

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2095.004196

I hereby certify that this correspondence is being deposited with the United States Postal Service via facsimile addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on **September 5, 2008**

Signature /Nancy Nolan/Typed or printed name **Nancy Nolan**

Application Number

10/781,029

Filed

February 17, 2004

First Named Inventor

Michael Stochosky

Art Unit

2146

Examiner

Gerald A. Smarth

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. **50,737**
Registration number _____

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September 5, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

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